

REMARKS

Claims 1 to 22 were pending in the application at the time of examination. Claims 1 to 22 stand rejected as obvious.

Claims 1 to 4, 7 to 11, 14 to 18, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,937,163, hereinafter referred to as Lee, in view of U.S. Patent No. 6,275,142 B1, hereinafter referred to as Paleiov.

Applicant respectfully traverses the obviousness rejection of Claim 1. Applicant first notes that the Examiner continues to interpret Lee in the same matter as in the prior anticipation rejection despite Applicant explicitly pointing out that Lee did not support the interpretation. In addition, Applicant filed a request for an interview, which was not granted, or responded to by the Examiner to address these issues.

Applicant notes that in the rejection, the Examiner admits that Lee fails to suggest Applicant's invention as recited in Claim 1 and then stated:

. . . Lee does not clearly show a list of index page types wherein the index page types include at least a table of contents and bibliography. Paleiov clearly discloses that data stored in memory 78 may include an author profile, printing history, bibliographic information, text, page numbers, tables, graphic images, computer program code, video, audio, graphic images, hyperlinks, nucleotide listings, or any other information suitable for storage in memory (col. 5 lines 51-64). It would have been obvious . . . to have the index pages with bibliographic and table of contents information of Paleiov in Lee's system to provide more related information on one location to ease the users when searching or organizing data.

Applicant first notes that the motivation supplied by the Examiner has nothing to do with Applicant's invention. Claim 1 recites:

A computer-based method of interactively generating an index page

Making it easier to search or organize data has nothing to do with "generating an index page." Therefore, the motivation for the combination of references is not appropriate. Further, the Examiner mischaracterizes the reference and shows that Applicant's claim language is being used to interpret the reference. The Examiner has cited no suggestion or teaching of a table of contents in Paleiov and instead relies upon a general comment on "tables" stored in a memory.

Finally, the portion of Paleiov cited by the Examiner is associated with parts of a book stored in a memory and is simply a laundry list of things that might be found in a book.

The Examiner uses a motivation unrelated to Applicant's invention and then selectively picks and chooses items from the laundry list of Paleiov to modify the primary reference. Finally, the Examiner fails to explain how the primary reference would be modified to include parts of a particular book in Lee. Thus, the motivation and rationale for the combination of references fails to comply with the requirements of the MPEP. Accordingly, Applicant respectfully submits that the Examiner has failed to establish a proper basis for the combination in view of the requirements of the MPEP. This alone is sufficient to overcome the obviousness rejection.

However, the Examiner's interpretation and reliance upon the primary reference also is not well founded. Again, Applicant points out that in interpreting Claim 1 for the obviousness rejection, the MPEP requires:

Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. (Emphasis in original.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-7, (May 2004).

The MPEP further requires:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. (Emphasis added.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-8, (May 2004).

Claim 1 recites a particular order and sequence of operations and elements used in those operations. The claim starts with general elements, and then upon an action further defines an element that is selected based upon that action. For example, Claim 1 first recites:

displaying a window including **a list of index page types;**
(Emphasis added.)

Thus, Claim 1 first recites that a window is displayed that includes "a list of index page types." Despite having traversed the characterization multiple times, the Examiner repeated the citation "(table of contents, col. 9, lines 59-67, and figs. 10-11)". This section describes that the table of contents is used to retrieve information associated with a URL or HTML link in the table of contents. This fails to teach anything concerning a list of index page types or anything concerning generating an index page. The Table of Contents of Lee exists and so there is no need to generate such a page.

Next, Claim 1 recites:

displaying a window including a list of index line types for one index page type **upon selection of said one index page type in said list of index page types;**
(Emphasis added.)

Thus, as recited in the claim, a selection of one index page type in the list in the first window results in display of a window including a list of index line types for the selected index page type. As noted above, the entries on the Table of Contents cited by the Examiner are not a list of index page types but rather URL and HTML links. Second, selection of an item in the Table of Contents results in retrieval of specific information, as quoted above from Lee. The Examiner has cited no teaching that this information is "a list of index line types for one index page type" that is associated with the selected index page type.

Instead, the Examiner cites "list of entries, col. 9, line 51-58 and elements 120' of fig. 10)." The Examiner is not following the sequence of limitations as recited in Claim 1 and is not following the operation of Lee, as described by Lee. Second, the Examiner has cited two different levels of the reference as teaching a single element in Applicant's claim, as discussed more completely below. Finally, the Examiner rejected "a list of entries" and not the specific list recited with the specific relationship to the previous element.

This is a further demonstration that the Examiner's interpretation of the reference is not well founded. The MPEP directs that explicit claim limitations must be considered and it is improper to reduce the claim language to a gist. Note that the above quotation from the MPEP requires "The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined." Also,

**DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF
AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT**

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP § 2141.02, Eight Edition, Rev. 2, p. 2100-125 (May 2004).

Moreover, Col. 9, lines 51 to 58 of Lee stated:

If one of these home page HTML links is executed, the display monitor illustratively may display a list of entries of the URLs and HTML links in the retrieved information immediately below the entry corresponding to the executed HTML link. This second list of entries may be indented two tab stops to indicate that such HTML links are on a level of the hierarchy below the executed HTML link. (Emphasis added.)

A list of links in retrieved information fails to teach "a list of index line types," as recited by Applicant. Also, Lee is clearly describing "This manner of presentation of information for retrieval from the server node defines a hierarchy of organization from the most general to the most specific." Lee at Col. 9 characterizes the section quoted by the Examiner, lines 48 to 51 as:

The entries for the retrieved URLs and HTML links on the home page are illustratively indented one tab stop to indicate that they are on a lower level of the hierarchy than the URL.

Thus, it is an indented link that is selected on the display that leads to the section cited by the Examiner. The items for element 120' are "Each book icon . . . corresponds to a distinct organization of URLs and HTML links for different topics of interest. Thus, the Examiner has cited two different hierarchical levels of Lee, a very top level that corresponds to a distinct organization, and a level that is below this very

top level as teaching Applicant's claim element. Two different things cannot teach or suggest what is claimed as required in the MPEP as quoted above and the Examiner has provided no rationale for modifying the explicit sequence of the primary reference. Applicant does not recite lists in the abstract, but rather specific types of lists that have a specified relationship to each other.

Lee stated "Note also the change in the iconic image of the Library icon 121' in the book shelf 120'. (Lee, Col. 14, lines 43-45.) Thus, Element 120' is described by Lee as "a book shelf." Earlier Lee stated "a row of icons 120 referred to as a book shelf. . . . The bookshelf 120 includes a number of smaller book icons 121-125, labeled library 121 . . ." Lee, Col. 11, lines 57-58. The Examiner has cited no teaching or suggestion that this row of icon is displayed "upon selection of one index page type." Moreover, a row of icons is not a list of index line types when a list of index line types is interpreted as required by the MPEP. The Examiner continues to use equivalent parts of Lee, elements 120 and 120' to teach two different parts of Claim 1.

Claim 1 further recites:

displaying a token string including a plurality of tokens for one index line type, upon selection of said one index line type in said list of index line types, wherein said plurality of tokens includes only tokens appropriate for said one index line type (Emphasis added.)

The Examiner has not explained how or where it is taught or suggested in Lee that the book icons cited by the Examiner are displayed "upon selection of said one index line type." The Examiner also has not explained or cited how Lee suggests that the book icons are "only tokens appropriate for said one index line type." In fact, the book icons are at the top of the hierarchy of Lee, as unambiguously stated by Lee in the text cited by the Examiner.

Claim 1 defines a relationship between the index page type and the index line type, and between the index line type and the token string. Book icons are at the top of Lee's hierarchy and to suggest that such top hierarchy icons teach or suggest limitations at a lower level hierarchy in Applicant's Claim 1 requires a modification of Lee. The Examiner has cited no teaching of index page types and elements for those index page types as recited in Claim 1. The Examiner citations to the secondary reference are not sufficient to overcome the shortcomings of the primary reference even if the combination were correct. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 4, and 7 depend from Claim 1 and so distinguish over the cited reference for at least the same reasons as Claim 1, which are incorporated herein by reference.

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 2 to 4, and 7.

With respect to the obviousness rejection of Claim 8, the Examiner simply repeated the rejection of Claim 8 from the final office action in the parent application. Thus, the rejection fails to address the amendment to Claim 8 made in the RCE filing.

Since the Examiner failed to make a new rejection, the Examiner failed to establish a prima facie obviousness rejection. Moreover, the action is incomplete because the Examiner dismissed Applicant's comments as moot based upon the new grounds of rejection. Simply changing a rejection from an anticipation rejection to an obviousness rejection fails to address the issues, because there is an implicit obviousness rejection in an anticipation rejection. If the Examiner's action is other than allowance, the next action should not be final and should directly address the issues raised by Applicant in the response to the final action, the amendment filed with the RCE and the above comments with respect to Claim

1 on the teaching and combination of references, all of which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 8.

Claims 9 to 11, and 14 depend from Claim 8 and so distinguish over the cited reference for at least the same reasons as Claim 8, which are incorporated herein by reference.

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 9 to 11 and 14.

With respect to Claim 15, the language discussed above with respect to Claim 1 is included in Claim 15. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 15. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 15.

Claims 16 to 18, and 21 depend from Claim 15 and so distinguish over the cited reference for at least the same reasons as Claim 15, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 16 to 18 and 21.

With respect to Claim 22, the language discussed above with respect to Claim 1 is included in Claim 22. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 22. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 22.

Claims 5, 6, 12, 13, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Paleiov in view of U.S. Patent No. 5,623,679, hereinafter Rivette.

Assuming that the combination of references is appropriate and the characterization of Rivette is correct, the information relied upon by the Examiner from the Rivette fails to address the shortcomings of the primary references and noted above for

Claims 1, 8, and 15. Moreover, the Examiner has failed to explain how Lee would be modified to generate a bibliographic reference since Lee is concerned with presentation of links in retrieved information and has failed to show how Lee would continue to work for its intended purpose after the modification. The MPEP requires:

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP § 2143.01, Eighth Edition, Rev. 2, p 2100-131, (May 2004).

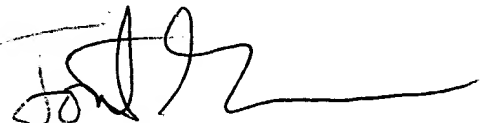
The Examiner's proposed modification of the prior reference would change the functionality of the primary reference. Therefore, according to the MPEP there is no suggestion of motivation to make the proposed modification. Thus, each of Claims 5, 6, 12, 13, 19 and 20 distinguishes over the combination of references. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 5, 6, 12, 13, 19, and 20.

Claims 1 to 22 remain in the application. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 4, 2004.

Respectfully submitted,



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Date of Signature